

REMARKS

In the Office Action mailed June 16, 2006, the Examiner rejected Claims 130-133 and 138-140 under 35 U.S.C. §103(a). This rejection is addressed below.

I. Rejection of Claims 130-133 and 138-140 under 35 U.S.C. §103(a)

Claims 130-133 and 138-140 were rejected under 35 U.S.C. §103(a) in light of Kim et al., 1998 J. Braz. Chem. Soc. 4:375-379 (hereinafter, “the Kim reference”) in combination with the present application, the prior art of record, or U.S. Patent No. 5,141,930 (hereinafter, “the ‘930 patent”).

In particular, the Examiner stated, “[the Kim reference]teach a 3-substituted 1,4-Benzodiazepin-2-ones such as compound 1 (see at page 375, Bz-423). Kim’s compound (i.e., Bz-423) meets all the claims except 1-aliphatic group substitution where the aliphatic group has at least 2 carbons...[T]he elongation of alkyl group from methyl to other lower alkyl groups (e.g., ethyl or propyl) is commonly practiced to extend the effective species, and thus said substitution is obvious...[O]ne would have been motivated to extend the species to include not only methyl but also ethyl, propyl, butyl, (lower alkyl groups) because the efficacy is well proven and suggested by both instant disclosure and prior art of record (see instant disclosure at page 32, second example containing 1-methyl substitution).” Office Action, page 3. The Applicants respectfully disagree.

The Examiner states, “one would have been motivated to extend the species to include not only methyl but also ethyl, propyl, butyl, (lower alkyl groups) because the efficacy is well proven and suggested by both instant disclosure and prior art of record.” Office Action, page 3. However, the Examiner fails to identify which prior art of record motivated or suggested the modification of a 1,4-benzodiazepin-2-one compound such that the first position is changed from having one or more carbons to two or more carbons. As an obviousness rejection requires an actual showing of where within a prior art reference the suggestion or motivation exists, identification of the particular prior art reference relied upon is required. MPEP §2143.01. Absent identification of a particular prior art reference and a citation within that reference indicating such a motivation, the rejection cannot stand. The Applicants request these rejections be withdrawn.

In addition, the Examiner's reliance on the Applicants' disclosure in establishing obviousness is in error. The Examiner relies upon a particular compound disclosed within the Specification of the present application as a motivation to modify 1,4-benzodiazepin-2-one compound such that the first position is changed from having one or more carbons to two or more carbons, as required in the claims. It is improper to use the Applicants' disclosure in such a manner. The Federal Circuit has repeatedly warned that a requisite motivation must come from the prior art, not an applicant's disclosure. See, *In re Dow Chem. Co.*, 837 F.2d 469, 473 (Fed. Cir. 1985). In addition, using an applicant's disclosure as a blueprint to reconstruct the claimed invention from isolated pieces of the prior art contravenes the statutory mandate of §103 of judging obviousness at the point in time when the invention was made. See, *Grain Processing Corp. v. American Maize- Prods. Co.*, 840 F.2d 902, 907 (Fed. Cir. 1988). As such, the Examiner's reliance upon the Applicants' disclosure as a motivation to modify the Kim reference is improper, and the Applicants request these rejections be withdrawn.

Finally, the Examiner states, “[t]he deficiency of Kim's teaching can also be remedied by Nakao et al (US 5141930) because Nakao teaches benzodiazepine compounds with N-substitution by methyl or any other aliphatic group (including ethyl substitution), wherein the efficacy of the compound is substantially the same and Nakao teaches the techniques and skills required for said substitution...One would have been motivated to do so, with reasonable expectation of success because it is always desirable to have extended therapeutic modalities to increase industrial applicability and selection option to benefit manufacturing process.” Office Action, page 4.

The Applicants respectfully submit that the '930 patent describes fused thiopene compounds – not benzodiazepine compounds. In particular, the background section of the '930 patent describes how the fused thiopene compounds improve over benzodiazepine compounds. As the '930 patent teaches away from any use of benzodiazepine compounds, the '930 patent does not motivate the modification of benzodiazepine compounds in the manner suggested by the Examiner. The Applicants request these rejections be withdrawn.

II. Conclusion

All grounds of rejection of the Final Office Action of June 16, 2006 have been addressed and reconsideration of the application is respectfully requested. It is respectfully submitted that Applicant's new claims should be passed into allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application Applicant encourages the Examiner to call the undersigned collect at (608) 218-6900.

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